

**REMARKS**

In response to the Office Action mailed June 6, 2003, Applicants respectfully request reconsideration. The Office Action did not indicate a shortened statutory period for reply. Therefore, this response should be considered timely filed, as it is being filed on the six month date from the date of the Office Action. No fee is believed to be required.

Claims 12-23 and 86-168 have been examined. By this Amendment, Applicants are canceling claims 125-168, without prejudice or disclaimer. In this respect, the Examiner indicated that claims 125-168 are drawn to non-elected subject matter. Without acceding to the proprietary of the restriction requirement, Applicants hereby cancel claims 125-168.

**Rejections Under 35 U.S.C. §103**

Claims 12-23 and 86-124 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of a U.S. Patent No. 5,719,948 (Liang). This rejection is respectfully traversed.

As mentioned in the previous response, Liang is directed to an authentication system that detects graphic images, indicia and/or characters that are either visible or fluorescent and made visible when exposed to UV light (see column 4, lines 10-29). A human or recognition logic 70 used in the system authenticates the image that is detected by the system by comparing the image to a predetermined image (see column 7, lines 15-45). The system returns an authentication signal to the user, thereby indicating whether the image is authentic. Further, although Liang detects light emission from the image, it is the *shape* of the image that is used to authenticate the item. That is, the system of Liang relies upon image or object recognition. Also, the image of Liang can be authenticated by a human without the use of a display, as the image may be made visible to a human (see abstract). That is, the image may be invisible initially, but when exposed to UV light, becomes fluorescent, and therefore viewable by the viewer without the aid of any image enhancing apparatus.

*Independent Claim 12*

Independent claim 12 is directed to an authentication device for authenticating a mark that is of any desired patent. More specifically, claim 12 recites, “a processor processes the data independent of the pattern of the mark and compares the data that is independent of the mark to a standard to render an authentication signal based on the comparison.” (Emphasis added). The device of claim 12 may authenticate a mark regardless of its shape, whereas Liang discloses an authentication system that authenticates a sample based on the shape of an image, using, for example, optical or image character recognition.

The Examiner indicates that the Liang reference does not teach that the processor processes the data independent of the pattern of the mark. The Examiner therefore states, “it is known in the art to use fluorescent marks on the object for authenticating articles. Both Falls and Shaw show this.” The Examiner concludes, “it would have been obvious to include this known coding method of product authentication with the system of Liang. This inclusion is not only known in the art, but is compatible with the marks and detection system taught by Liang.” The Examiner continues, “it would have been obvious to include in the system of Liang because it would provide and [sic] additional level of security by adding an additional test of authenticity, the coded fluorescents, in a manner already largely provided for by the system of Liang.”

Applicants respectfully request reconsideration, as the Examiner has failed to provide a *prima facie* case of obviousness.

As an initial matter, the Examiner does not rely on a combination of Liang with either Falls and/or Shaw but instead uses Falls and Shaw to show that a component that Liang lacks is known in the art. This is not the test under 35 U.S.C. §103. Rather, the Examiner must show that it would have been obvious to one of skill in the art to modify Liang in the manner suggested in order to render the Applicants’ claimed invention obvious.

It is well settled that the notion that combination claims cannot be declared unpatentable merely upon finding similar elements in separate prior patents, as this

would necessarily destroy virtually all patent applications and is not the law. It is simply insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion in the prior art to combine the elements. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious, unless the prior art suggested the desirability of the modification.

Here, Liang fails to suggest such a motivation. In fact, Liang teaches away from such a modification. Liang is specifically directed to a system that is used to view the image using recognition software and compare that image to a stored image. Only if the images match up is an authentication signal returned. Thus, Liang teaches away from rendering an authentication signal independent of the pattern of the mark. Rather, in Liang, the shape of the image itself is important.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 12, and its dependent claims, as a *prima facie* case of obvious has not been provided.

Independent Claim 90

Independent claim 90 is directed to an authentication device that detects the first intensity at a first wave length and a second intensity at a second wave length and calculates a ratio of the first intensity to the second intensity or a ratio of the first wavelength to the second wavelength. This ratio is then compared to a standard to render an authentication signal.

The Examiner appears to have summarily rejected claim 90 and its dependent claims as being obvious in view of Liang. However, the Office Action does not separately discuss claim 90, and it is unclear to the Applicants how the Examiner has come to the conclusion that claim 90 is obvious. Nowhere in Liang is there a discussion of processing signals to produce a ratio. In addition, Liang does not suggest or even hint at the possibility of using signal ratios to render an authentication result. Accordingly, the Examiner has not set forth a *prima facie* case of obviousness and the rejection of claim 90 and its respective dependent claims should be withdrawn.

Independent Claim 108

Claim 108 is directed to a system comprising a detection device comprising a snapshot display and an invisible mark that is viewable **only** through the snapshot display.

Again, it is unclear from the Office Action how the claim is rendered obvious in view of Liang. In this respect, the Office Action is silent as to how Liang may be modified to disclose a system in which an invisible mark is made viewable only through the snapshot display.

As discussed above, Liang requires UV light to illuminate an invisible image. Once the image is excited, a human can read the image. As clearly pointed out by the Examiner in the Office Action, the Liang reference discusses human observation where the characters are made readable “once they are made visible” (abstract, lines 9-10). Therefore, if Liang were modified such that the image was viewable only in the snapshot mode, it would frustrate the purpose of Liang, namely providing a “first-order authentication by a human observer” as recognized by the Examiner.

Thus, Liang does not teach, suggest or disclose a mark that is invisible but made readable only by viewing through the snapshot display. Accordingly, Applicants respectfully request that the rejection of claim 108, and its dependent claims, be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

*McInerney et al., Applicants*



---

Neil P. Ferraro, Reg. No. 39,188  
WOLF, GREENFIELD & SACKS, P.C.  
600 Atlantic Avenue  
Boston, MA 02210  
(617) 720-3500

Date: December 8, 2003  
**12/06/03X**